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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,131	06/20/2000	Jeffry Jovan Philyaw	PHLY-25,357	6197
25883	7590	12/07/2005	EXAMINER	
HOWISON & ARNOTT, L.L.P			FISCHER, ANDREW J	
P.O. BOX 741715			ART UNIT	
DALLAS, TX 75374-1715			PAPER NUMBER	
			3627	
DATE MAILED: 12/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/597,131

Applicant(s)

PHILYAW, JEFFRY JOVAN

Examiner

Andrew J. Fischer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination (“RCE”) under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application on September 8, 2005. This application was under a final rejection (the “Second Final Office Action” mailed September 8, 2004) and is therefore eligible for continued examination under 37 C.F.R. §1.114. Because the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality in the Second Final Office Action has been withdrawn pursuant to 37 C.F.R. §1.114.

Acknowledgements

2. In accordance with the RCE noted above, Applicant’s amendment filed September 8, 2005, has been entered. Accordingly, claims 1-22 remain pending.

3. This Office Action, the “Third Non Final Office Action” is given Paper No. 20051128.

4. All references in this Office Action to the capitalized versions of “Applicant” refers specifically the Applicant of record. References to lower case versions of “applicant” or “applicants” refers to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” in this Office Action refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally.

5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Specification

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o); and MPEP §2181.

Correction of the following is required:

- i. In claim 22, the “means for transferring said extracted encoded information from said MRC”

Claim Rejections - 35 USC §112 2nd Paragraph

7. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-11 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

- a. Claim 1 recites the limitation “the step of extracting unique identification information associated with the user” in lines 8 and 9. There is insufficient antecedent basis for this limitation in the claim.
- b. Also in claim 1, it is unclear if “the step of extracting” in “after the step of extracting” as recited in line 10 is referring to “extracting the encoded information from the MRC” as recited in line 5, or alternatively, “the step of extracting unique identification information associated with the user” as recited in lines 8 and 9.

Art Unit: 3627

c. Claims 12-22 are indefinite because Applicant has not clearly linked and associated any corresponding structure with the claimed “means for transferring said extracted encoded information from said MRC”

d. In claims 1 and 12, it is unclear when the “transferring ownership of the article of commerce” takes place. Applicant’s arguments suggest that that the transfer of ownership takes place upon the actual scanning of the article. While the Examiner agrees this may initiate the transaction, it is clear it will not finalize the contract or bargain.

9. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC §102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

Art Unit: 3627

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 12-22, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Ogasawara (U.S. 6,123,259). Ogasawara discloses the following: a UPC code (column 11, last paragraph); an extraction circuit (within scanner 15); a temporary buffer (inherent in any CPU); an identification device (device that identifies the product scanner); a retail processing system (inherent); ownership of the article is transferred after receiving encoded information (and payment); the scanner has a unique id (column 10, paragraph starting on line 25); the personal scanner is wireless (wireless to the main store server 50 and its database); the user has an account set up for them prior to receiving the scanner (inherent); the scanner has at least some memory (which is a temporary buffer).

12. Claims 1-11, as understood by the Examiner, are also rejected under 35 U.S.C. §102(e) as being anticipated by Ogasawara. Because Group I is not patentably distinct from Group II, the patentability of Group I stands or falls with the patentability of Group II.

Claim Rejections - 35 USC §103

13. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3627


14. Claims 1-12 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Ogasawara in view of Swartz et. al. (U.S. 5,923,735)("Swartz '735").¹ It is the Examiner's principle position that the methods are anticipated purchasing is inherent in Ogasawara since Ogasawara directly discloses tracking purchases [C16, L11-19] of scanned items and sending the article of commerce information to a POS device after scanning [C16, L36-39].

However, even if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ogasawara as taught by Swartz '735 to include more detail on how to purchase the item. Swartz '735 directly discloses how a portable scanning terminal is used to purchase articles of commerce. Such a modification of Ogasawara would have included more details of how the purchase actually occurs.

15. Claims 12-22 are also rejected under 35 U.S.C. §103(a) as being unpatentable over Ogasawara in view of Swartz '735. Because Invention I (claims 1-11) are not patentably distinct from Invention II (claims 12-22), the patentability of claims 12-22 with regards to Ogasawara stands or falls with the patentability of claims 1-12.

16. Claims 1-12 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Ogasawara in view of Petrovich et. al. (U.S. 6,101,483)("Petrovich"). It is the Examiner's principle position that the methods are anticipated purchasing is inherent in Ogasawara since Ogasawara directly discloses tracking purchases [C16, L11-19] of scanned items and sending the article of commerce information to a POS device after scanning [C16, L36-39].

17. However, even if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ogasawara as taught by Petrovich to include

 ¹ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

Art Unit: 3627

more detail on how to purchase the item. Petrovich directly discloses how a portable scanning terminal is used to purchase articles of commerce. Such a modification of Ogasawara would have simply included more details of how the purchase actually occurs.

18. Claims 12-22 are also rejected under 35 U.S.C. §103(a) as being unpatentable over Ogasawara in view of Petrovich. Because Invention I (claims 1-11) are not patentably distinct from Invention II (claims 12-22), the patentability of claims 12-22 with regards to Ogasawara stands or falls with the patentability of claims 1-12.

19. As noted in the previous office action(s), the Examiner maintains his position that Applicant has decided not to be his own lexicographer. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.²

20. Under the broadest reasonable interpretation standard noted above and unless expressly modified in this Third Non Final Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous office action(s). Those previous definition(s) are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary³) during ex parte examination.

² See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

³ See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) ("[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.").

Art Unit: 3627

21. As noted in the previous office action(s), the Examiner maintains his position that Applicant has elected not to recite any product-by-process claims.

22. As noted in the previous office action(s), and except for the application of 35 U.S.C. §112, 6th paragraph, the Examiner maintains his position regarding functional language (*i.e.* “for initiating and completing a commercial transaction” as recited in claim 1).

23. As noted in the previous office action(s), the Examiner maintains his position regarding the interpretation and application of 35 U.S.C. §112, 6th paragraph.

Response to Arguments

24. Applicant’s arguments filed September 8, 2005 have been fully considered but they are not persuasive.

25. Regarding the 35 U.S.C. §112, 2nd paragraph rejection for failing to clearly link and associate, Applicant’s response is not persuasive. In particular, the Examiner reviewed Applicant’s “Remarks” beginning on page 7 and nevertheless, can not locate where Applicant states the corresponding structure for the cited function. While Applicant discusses the operation of the claimed invention, he still does not recite what is the *particular* corresponding structure for the phrase that invokes 35 U.S.C. §112, 6th paragraph (*i.e.* the Means Phrase #1 as noted in the Second Final Office Action). Applicant’s arguments have been considered but are not persuasive.

26. With respect to Ogasawara, Applicant argues that “the Examiner did not specifically point to any specific language in Ogasawara for the payment provision in response to the information transferred ‘from the extraction device’ to the POS. . . . Ogasawara is nothing

Art Unit: 3627

more than a portable scanner that is utilized to keep a history of lists and location information . . .

.”⁴ The Examiner respectfully disagrees. First, in Ogasawara, the items are clearly purchased.

See Ogasawara C16, L12-17, where the system tracks which items on the list are actually purchased. In order to do this, the system must keep track of purchased items. Additionally, Ogasawara directly discloses sending the items that the user desires to purchase to the POS system. See Ogasawara for example, C16, L37-39.

Conclusion

27. References considered pertinent to Applicant’s disclosure are listed on form PTO-892.

All references listed on form PTO-892 are cited in their entirety.

28. The following three (3) citations to the Manual of Patent Examining Procedure (“MPEP”) apply to this Office Action: MPEP citations to Chapters 200-900, 1200-1400, and 1700-1900, 2100, 2200, 2600 are from the MPEP 8th Edition, Rev. 3, August 2005. MPEP citations to Chapters 100, 1000, 1100, 1500, 2000, 2500, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. MPEP citations to Chapters 1600, 2300, 2400 are from MPEP 8th Edition, August 2001.

29. This application is a continuation-in-part (“CIP”) application of U.S. application number 09/378,221 filed on August 19, 1999, now U.S. Patent 6,745,234 B1 (“Parent Application”). See MPEP §201.06. Additionally, the Parent Application is a CIP of U.S. application number 09/151,471 (“Grand Parent Application”) which is now abandoned. In accordance with MPEP §609 A. 2 and MPEP §2001.06(b) (last paragraph), the Examiner has reviewed and considered the prior art cited in both the Parent Application and the Grand Parent Application. Also in

⁴ Applicant’s “Arguments” filed September 8, 2005, Page 8, 5th ¶.

Art Unit: 3627

accordance with MPEP §2001.06(b) (last paragraph), all documents cited or considered 'of record' in both the Parent Application and the Grand Parent Application are now considered cited or 'of record' in this application. Additionally, Applicant is reminded that a listing of the information cited or 'of record' in the Parent Application need not be resubmitted in this application unless Applicant desires the information to be printed on a patent issuing from this application. See MPEP §609 A. 2. Finally, Applicant is reminded that the prosecution history of the Parent Application is relevant in this application. See *e.g., Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350, 69 USPQ2d 1815, 1823 (Fed. Cir. 2004) (holding that statements made in prosecution of one patent are relevant to the scope of all sibling patents).

30. In light of the Examiner's consideration of the documents as noted in the paragraph immediately above, because of the large number of utility patent applications originating from the Grand Parent Application and/or Parent Application, and because of the changing nature of the claims associated with the claim amendment(s) in these familial applications, Applicant is required to inform the Examiner (by providing both U.S. application serial number (or U.S. patent number if issued) and relevant claim number(s)) of any other patent application that Applicant reasonably believes may result in double patenting rejection(s) in this application. This requirement shall remain in effect up until either the date of abandonment or the date of issuance of this application.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3627

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

32. Applicant is reminded that patents are written by and for skilled artisans. See *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicant is a skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicant is hereby given actual notice that if after reasonably reading any reference of record, if Applicant can not reasonably understand or if Applicant has difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in one or more of the reference(s) of record, Applicant should (in his next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicant’s response must also state *why* they either do not understand or have difficulty comprehending the reference. If after properly receiving (*i.e.* Applicant’s response is made of record) both Applicant’s request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) at issue in a reasonable manner.

Art Unit: 3627

33. Also in accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the reference The Bank Credit Card Business by the American Bankers Association (hereinafter “ABA”) is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The Examiner finds that ABA is a textbook in English that introduces the reader to the dynamic bank credit card business. Like all references cited by the Examiner, this reference is cited in its entirety. Moreover, because “[w]ell known text books in English are obvious research materials.” *In re Howarth*, 654, F.2d 103, 210 USPQ 689, 692 (CCPA 1981), because the reference’s general description of the credit card business, because of the reference’s basic content which is self evident upon review of the reference, and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that ABA is primarily directed towards those of low skill in this art. Because ABA is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must-at the very least-be aware of and understand the knowledge and information contained within ABA.

34. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his “Remarks” (beginning on page 7) traversing the Examiner’s positions on various points. If Applicant disagrees with any additional factual determination or legal

Art Unit: 3627

conclusion made by the Examiner in this Office Action whether expressly stated or implied,⁵ the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.

Handwritten signature of Andrew J. Fischer, dated 11/28/05.

Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
November 28, 2005

⁵ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.